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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,130	09/22/2003	Hans-Ulrich Maier	Q77163	8418

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EXAMINER

MCCARTHY, CHRISTOPHER S

ART UNIT PAPER NUMBER

2113

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,130

Applicant(s)

MAIER ET AL.

Examiner

Christopher S. McCarthy

Art Unit

2113

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>response to arguments</u> . |

DETAILED ACTION

1. Claims 1-3, 7-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bealkowski et al. U.S. Patent 5,410,699.
2. Claims 4, 5, 11, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bealkowski in view of Grawrock U.S. Patent Application Publication US2002/0087877.
3. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 101

4. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim language, as amended, still contains a software module. Software is not patentable of itself, but must be in combination with hardware. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. MPEP § 2106 (IV) (B) (1) (a).

Claim Rejections - 35 USC § 102

Art Unit: 2113

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bealkowski et al. U.S. Patent 5,410,699.

As per claim 1, Bealkowski teaches a computer-implemented method for recovering data in a data processing system in which the recovery is carried out exclusively in predetermined units or installations, wherein a recovery program is executed in the data processing system (column 3, lines 1-7), wherein a test procedure of predefined hardware features of the data processing system is executed (column 3, lines 19-22; column 7, lines 16-19), wherein the recovery carried out is non-destructive (column 10, lines 47-49, wherein an update to the system does not teach an overwrite or destruction of the prior version), and wherein all the features that are characteristic of the data and the system are stored in a control file of the recovery program (column 3, lines 19-22; column 7, lines 16-19).

As per claim 2, Bealkowski teaches the computer-implemented method as claimed in claim 1, wherein the test procedure analyzes special hardware features of the data processing system that are stored in a predefined memory area of the data processing system and, if the special hardware features match with defaults in the control file, execution of the recovery program is continued and, if not, execution of the recovery program is aborted (column 12, lines 1-7; column 3, lines 53-66).

As per claim 3, Bealkowski teaches the computer-implemented method as claimed in claim 2, wherein the special hardware features have been stored as data strings in BIOS of the data processing system (column 7, lines 7-24).

As per claim 7, Bealkowski teaches a device for carrying out the computer-implemented method as claimed in claim 1, wherein the data processing system has a processor module, a working memory and additional storage and input media for executing the recovery program (column 4, line 64 – column 5, line 18).

As per claim 8, Bealkowski teaches a software module for carrying out the computer-implemented method as claimed in claim 1, wherein the software module is programmed to have program steps with which the recovery program is executed in the data processing system (column 3, lines 1-7).

As per claim 9, Bealkowski teaches a computer-readable medium with a software module as claimed in claim 8, wherein the computer-readable medium contains at least one of unencrypted and encrypted data to be recovered as well as the recovery program including the control file, and wherein the computer-readable medium is configured to be read into the data processing system by means of a data input device (column 3, lines 10-18, 41-52).

As per claim 10, Bealkowski teaches the computer-readable medium data carrier with the software module as claimed in claim 9, wherein the data input device comprises a reader (column 5, lines 11-19).

As per claim 12, Bealkowski teaches the computer-implemented method as claimed in Claim 1, wherein the recovery program comprises instructions for recovering at least some of data of the data processing system lost in a failure of the data processing system (column 2, line

65 – column 3, line 7, wherein, Bealkowski teaches the system configurations are retrieved from the diskette upon failure of the fixed disk).

As per claim 13, Bealkowski teaches the computer-implemented method as claimed in Claim 1, wherein the recovery program is executed on an operating system (column 4, line 67 – column 5, line 2).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, 11, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bealkowski in view of Grawrock U.S. Patent Application Publication US2002/0087877.

As per claim 4, Bealkowski teaches a computer implemented method as claimed in claim 1. Bealkowski does not explicitly teach wherein the data to be recovered is at least in part encrypted data. Grawrock does teach wherein the data to be recovered is at least in part encrypted data (paragraph 0014). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the data encryption process of Grawrock to the recovery process of Bealkowski. One of ordinary skill in the art would have been motivated to combine the data encryption process of Grawrock to the recovery process of Bealkowski because Grawrock teaches using the encryption of data to protect the integrity of the data being transferred (paragraph 0018); an explicit desire of Bealkowski (column 11, lines 56-57).

As per claim 5, Bealkowski in view of Grawrock teaches a computer implemented method as claimed in claim 4 as cited above. Bealkoswksi does not explicitly teach wherein the data to be recovered is at least in part unencrypted data. Grawrock does teach wherein the data to be recovered is at least in part unencrypted data (paragraph 0014). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the data encryption process of Grawrock to the recovery process of Bealkoski. One of ordinary skill in the art would have been motivated to combine the data encryption process of Grawrock to the recovery process of Bealkoski because Grawrock teaches using the encryption of data to protect the integrity of the data being transferred (paragraph 0018); an explicit desire of Bealkowski (column 11, lines 56-57).

As per claim 11, Bealkowski teaches a computer-readable medium according to claim 9. Bealkowski does not teach wherein the computer-readable medium contains both unencrypted data and encrypted data to be recovered. Grawrock does teach wherein the data to be recovered is at least in part unencrypted data (paragraph 0014). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the data encryption process of Grawrock to the recovery process of Bealkoski. One of ordinary skill in the art would have been motivated to combine the data encryption process of Grawrock to the recovery process of Bealkoski because Grawrock teaches using the encryption of data to protect the integrity of the data being transferred (paragraph 0018); an explicit desire of Bealkowski (column 11, lines 56-57).

As per claim 14, Bealkowski teaches the computer-implemented method as claimed in Claim 1 with test procedures. Bealkowski does not teach wherein the recovery program

comprises recovering encrypted and unencrypted data of the data processing system. Grawrock does teach wherein the data to be recovered is at least in part unencrypted data and encrypted data (paragraph 0014). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the data encryption process of Grawrock to the recovery process of Bealkoski. One of ordinary skill in the art would have been motivated to combine the data encryption process of Grawrock to the recovery process of Bealkoski because Grawrock teaches using the encryption of data to protect the integrity of the data being transferred (paragraph 0018); an explicit desire of Bealkowski (column 11, lines 56-57).

Allowable Subject Matter

7. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 8/4/06 have been fully considered but they are not persuasive.

The applicant has argued that Bealkowski does not teach a recovery program, but only a recovery mode of the system. The examiner respectfully disagrees. Bealkowski teaches in column 3, lines 36-40, wherein the BIOS attempts to read in the master boot record from the fixed disk and, then because of the failure to do so by the fixed disk, the BIOS reads the master

boot record from the diskette. The BIOS is pre-programmed by some means to take the next step of reading the diskette. It can at least be said that since the BIOS is performing this function, that it can be initiating or following a program routine of reading the diskette upon failure of the fixed disk; therefore, it is deemed as part of a recovery program.

The applicant also has argued that Bealkowski does not teach all features that are characteristic of the data and the system are stored in the control file. The examiner respectfully disagrees. As mentioned above, a master boot record is read by the BIOS. Bealkowski further teaches that this record includes data segments that contain data representing system hardware, and a system configuration. The examiner contends that this broadly teaches that the hardware and system configurations of said hardware include system software and, therefore, include all features of the system.

The applicant has also argued that Bealkowski does not teach wherein recovery is non-destructive. The examiner respectfully disagrees with the definition of non-destructive as implied by the applicant's remarks. The applicant has argued that updating an image is modifying or changing the image, and is therefore destructive. Using this rationale, than any data or bits in the failed system can not be altered or modified upon recovery, even unused space in another partition can not be used as the data bits would be changed by the recording thereupon in recovery. If the applicant contends that this is the intended definition, then that distinctive language needs to be in claim language. If however, the examiner has mis-interpreted the definition of non-destructive, then clarification is suggested. Also, the examiner respectfully disagrees that updating is a destructive act. For example, updating an operating system, i.e. Windows, with a patch does not destroy the prior version of Windows, otherwise, re-installation

of the entire Windows program would need to be re-installed every time an update occurs. The examiner contends that the basic definition of “destructive” which is a derivative of “destruction” means to destroy or ruin in nature. The examiner contends that Bealkowski is not destroying the old image upon updating it, but merely expanding it.

In light of the above arguments, all applicable rejected claims stand.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. McCarthy whose telephone number is (571)272-3651. The examiner can normally be reached on M-F, 9 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on (571)272-3645. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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